



Application No. 09/634,612

Art Unit: 3622

Appellant's Reply to New Grounds of Rejection in Examiner's Answer of 05-18-06

July 18, 2006

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: RONALD JOHN ROSENBERGER

Application No.: 09/634,612 **Art. Unit:** 3622

Filing Date: August 5, 2000 **Examiner:** James W. Myhre

Title: HEALTH REMINDERS FOR END USERS OF FINANCIAL CARD SERVICES

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Ronald Rosenberger



Date

**APPELLANT'S REPLY TO NEW GROUNDS OF REJECTION IN
EXAMINER'S ANSWER UNDER 37 CFR 41.39(b) IN THE FORM OF A
SUBSTITUTE APPEAL BRIEF UNDER MPEP 1207.03V.B**

In response to the Examiner's Answer mailed May 18, 2006, with a response due July 18, 2006, and in conjunction with the Notice of Appeal filed on September 22, 2005, in the above-referenced case, for which Applicant (Appellant) submitted a timely Appeal Brief on December 22, 2005, Applicant-Appellant submits the following Appellant's Reply to New Grounds of Rejection under 37 CFR 41.39(b) in the form of a Substitute Appeal Brief under MPEP 1207.03V.B that addresses requirements under 37 CFR 41.37(c).

Real Party in Interest (37 CFR 41.37(c)(1)(i))

The Applicant-inventor, Ronald Rosenberger is the owner of entire interest in the above-identified patent application as the sole Applicant, and which interest has not been assigned.

Related Appeals and Interferences (37 CFR 41.37(c)(1)(ii))

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal and accordingly there are no decisions to provide copies herewith.

Status of Claims (37 CFR 41.37(c)(1)(iii))

There were no amendments filed subsequent to the final office action. Original claims 1-145 have been canceled prior to the pending final office action. Claims 146-205 are now rejected and appealed. All of the pending claims stand rejected as being unpatentable over the prior art of record for anticipation under.

Status of Amendments (37 CFR 41.37(c)(1)(iv))

There were no amendments made subsequent to the final office action.

Summary of Claimed Subject Matter (37 CFR 41.37(c)(1)(v))

The presently claimed invention provides a method for providing health reminders with transaction statements sent to or accessed by end users of financial cards and related financial card customer services, wherein the health reminder is not related to a product purchase listed on the transaction statement. The present claims are fully supported by the original specification and claims as filed, e.g., pages 19, lines 5-11, and figures 4-6, of the original specification as reformatted in the Preliminary Amendment mailed October 25, 2001, and at page 12, lines 15-27, of the Preliminary Amendment, mailed April 22, 2002.

Grounds of Rejection to be reviewed on Appeal (37 CFR 41.37(c)(1)(vi))

Whether the Examiner has provided a reference or combination of references that have failed to suggest each and every element of the present claims along with a motivation to combine the cited references and renders the present claims prima-facie obvious.

Argument (37 CFR 41.37(c)(1)(vii))

All of the claims, including independent claims 146 and 176, are argued together.

On pages 2-9 of the Final Office Action dated June 23, 2005, and the Advisory Action mailed August 3, 2005, the Examiner maintains the rejection of claims 146-205 under 35 USC 103(a) as obvious over the combination of Byerly et al and Bucci, in view of Masuda (US patent No. 5,569,897), for the reasons presented in the final Office Action.

In the Examiner's Answer, the Examiner responds to Applicant's position as the following presented below in the Appeal Brief, but the Examiner quotes and underlines portions of a quote from Byerly et al, but ignores and fails to underline the part of the quote that completely supports Applicant's position.

The Examiner in a new ground of rejection quotes and underlines Byerly as follows:

"all types of information provides to pharmacy patients, including information about the prescribed product or procedures, patient-specific information (such [as] scheduling of appointments, physicals, etc.), promotional materials and/or discount information pertaining to the purchase of prescription products and/or other products and/or simply news items pertaining to the dispensed product and/or pharmaceutical products and/or health in general" (emphasis added) (col. 2, lines 53-63).

However, the quote as a whole directly supports Applicant's position, as already presented:

In contrast to the teachings of the cited references, the presently claimed invention provides a method for providing health reminders with transaction statements sent to or accessed by end users of financial cards and related financial card customer services, wherein the health reminder is not related to a product purchase listed on the transaction statement.

In fact, if the quote by the Examiner is properly emphasized, it directly supports Applicant's position that the cited reference fails to suggest the presently claimed invention in that it does not relate to financial cards and related financial card customer services that provide a health reminder that is not relate to the product purchased:

“all types of information provides to pharmacy patients, including information about the prescribed product or procedures, patient-specific information (such [as] scheduling of appointments, physicals, etc.), promotional materials and/or discount information pertaining to the purchase of prescription products and/or other products and/or simply news items pertaining to the dispensed product and/or pharmaceutical products and/or health in general” (emphasis added) (col. 2, lines 53-63).

So, in every case, the additional information is in some form related to the purchased product, in that it is always provided as related to a purchase of a pharmaceutical or related product, in complete contradistinction to the presently claimed invention. The Examiner attempts to argue that there is other information that about the product, but the purchase from a pharmacy is always tied to the prescription product and is not based on the presently claimed financial card used, which has a health reminder unrelated to the purchased product.

Byerly et al merely teaches adding medical advisory information to pharmacy transaction information that is pertaining to the pharmaceutical product or related product which the patient had bought at the pharmacy. This aspect of Byerly is

specifically excluded from the present claims such that Byerly cannot suggest or teach the presently claimed invention.

In a new ground of the rejection presented in the Examiner's Answer on page 3, the Examiner cites page 3 of Bucci, asserting that

“Bucci was used to show customer transaction statement, which not only included the transaction information, but also additional ‘hard-copy material in the nature of advertising or bill-breakdown information, being mailed to the customer...the motivation to combine the references was to allow the customers in Byerly to conduct telephonic, mail order, or on-line transaction with the Pharmacy”.

Applicant responds that the presently claimed invention does in no way relate to pharmaceutical or other pharmacy product related information with the pharmacy purchase of such pharmacy products. The new ground of rejection, that the teaching of Bucci provide advertising or bill related information along with the combining several financial statements into a single statement, still in no way relates to the presently claimed invention of providing health reminders on financial card statements that are unrelated to the products being purchased. Accordingly, one of ordinary skill in the art would not have ascertained the presently claimed invention (which also comprises financial cards and related financial card customer services that enable end users to engage in purchase transactions) from the cited references, as asserted by the Examiner in the Examiner's Answer.

Bucci fails to teach or suggest the presently claimed invention in that Bucci teaches the electronic or computer combination of several financial services transaction accounts into a single printed transaction statement. Bucci is thus completely unrelated to Byerly et al and the Examiner has combined these references using impermissible hindsight of the teachings of the present application. The cited art must provide a motivation to combine the references and the cited references fail to provide such a motivation, and in fact teach away from such a combination.

Masuda teaches a credit card system that has an identity checking features that confirms that the credit card is be used by the person the card was issued to. It should be made clear that Masuda merely teaches a credit card identity system, and, unlike the present invention, totally fails to teach the claimed "related financial card customer services". Masuda is also completely unrelated to both Bucci and Byerly and the Examiner has combined these references using impermissible hindsight of the teachings of the present application. The cited art must provide a motivation to combine the references and the cited references fail to provide such a motivation, and in fact teach away from such a combination.

Applicant respectfully submits that one of ordinary skill in the art would not be taught or motivated to provide health reminders with financial card transaction statements that are not related to a pharmacy purchase, sent to or accessed by end users of financial cards and related financial card customer services, using the combination of Byerly et al and Bucci, in view of Masuda.

The presently claimed invention is not taught or suggested by the cited references and there is **no motivation to combine** the references unrelated teachings of:

- (i) Byerly's teaching of adding medical advisory or related information to pharmacy transaction information that is relevant to the pharmaceutical or other pharmacy product which the patient had bought at the pharmacy; in combination with
- (ii) Bucci's teaching of the electronic or computer combination of several financial services transaction accounts into a single printed transaction statement, that can include advertising or bill breakdown information; further in combination with
- (iii) Masuda's teaching of a credit card system that has an identity-checking which confirms that the credit card is being used by the person the card was issued to

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where the teaching,

suggestion, or motivation to do so is found either explicitly or implicitly in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (Discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

MPEP

2143.01

The Examiner has failed to establish a prima facie case of obviousness because the cited references fail to teach the presently claimed invention and there is no motivation to combine the references.

The cited references also **teach away** from the presently claimed invention. The Examiner has used **impermissible hindsight** from the present specification and also mischaracterized the cited references by ignoring the features of the subject matter taught by the references and picking and choosing features of the present invention into the references using impermissible hindsight provided by the present specification. The Examiner also makes the statement that the references do not have to suggest the combination to render obvious the claims. This is not correct. The motivation to combine the references must be provided by the cited references, which the cited references fail to do.

In a new ground of rejection on page 5 of the Examiner's Answer, the Examiner, as he has done in all of the rejections, has improperly generalized the invention using hindsight of the present specification and claims to attempt to encompass both the presently claimed invention and the prior art:

“both references disclose combining transaction information with additional information and presenting the combined information to the user.”

The present claims DO NOT recite “combining transaction information with additional information and presenting the combined information to the user.” The presently claimed methods provide health reminders on financial card statements that are unrelated to the products being purchased. As presented above the references fail to suggest or teach the presently claimed method.

As presented in further detail below, Byerly et al and Bucci are completely unrelated to each other and also do not in any way teach or suggest the presently claimed method. Byerly et al and Bucci teach away from each other and thus cannot be properly combined either with each other or together with Masuda. Additionally, the asserted combination can only be combined using impermissible hindsight of the teaching of the present specification.

There is also no motivation to combine Byerly et al and Bucci due to the fact that the two references “teach away” from each other in three distinct ways, as presented in greater detail below. Only by improperly using hindsight based on the teaching of the present specification would one of ordinary skill in the art combine the teachings of the cited references.

The combination of Masuda and Byerly et al would require that Byerly et al teach a credit card, which Byerly et al completely fails to do. There is no possible relationship between Masuda and Bucci because Bucci also fails to teach or suggest a credit card, where Bucci merely teaches to consolidate bills into a single statement, which has no relationship to the presently claimed invention. Nonetheless, each of the cited references of Masuda, Byerly et al, and Bucci, as well as the impermissible combination of the three, *totally fails* to teach the claimed “related financial card customer services”.

The “teach away” descriptions presented by Byerly et al and Bucci are presented in more detail below. In particular, the following establishes that Bucci and Byerly et al

“teach away” from each other in three ways: 1) with regards to method of delivery of materials to the end user; 2) with regards to periodicity of the receipt of materials by the end user; and, 3) with regards to when payment is made in relation to the consumption of products or services. In light of the fact that the references “teach away” from each other to such extents, there is nothing in either of the references that would suggest that the motivation for combining the references is known outside of the teaching of the present specification. As a result, the combination can at best be obvious in hindsight, which is impermissible. Accordingly, Byerly and Bucci cannot be combined, and thus cannot also be combined with Masuda.

Additionally, MPEP specifically prohibits the type of combination that the Examiner has made in this rejection, for example, at section 2143.01, and especially as described in detail in this section under the headings toward the end of the section “THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE” and “THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE”.

“TEACH AWAY” COMPARISONS

BUCCI (5,655,089) VS BYERLY ET AL (6,067,524)

WITH REGARDS TO METHOD OF DELIVERY OF MATERIALS TO THE END USER

Bucci: Materials are mailed, or “electronically” transmitted; the end user does not have to *come* to Bucci, Bucci sends the materials *to* the end user.

Byerly et al: The end user picks up the advisory message during the Pharmacy transaction; the end user must come to the retail store environment of a Pharmacy.

Byerly et al refers to retail pharmacy customers or end users as “pharmacy patients” (column 1, lines 21 and 24), or a singular retail pharmacy customer or end user as a

“patient” (column 6, line 41). Furthermore, Byerly et al explicitly “teaches away” from *mailing* the “advisory message”, as is seen in column 6, lines 39-48:

“The advisory message 440 can be in the form of a patient-customized newsletter, and it can be delivered to the patient by the pharmacist. Studies have shown that patients regularly use pharmacists as a source of medical information since pharmacists are believed act objectively for the patient's best interests. Accordingly, having the advisory information presented to a patient by his or her pharmacist is a reliable and effective method of providing health advisory information as compared to conventional methods, such as mass mailings, targeted mailings, etc.”

RATIONALE – Bucci and Byerly et al “teach away” from each other with regard to means of delivery. Bucci teaches mailing or electronic transmission, whereas Byerly et al teaches actual pickup of advisory messages at the pharmacy by the “pharmacy patient” end user, which enables live interaction with the pharmacist, which is deemed by Byerly et al as being desired and greatly preferred to alternatives such as “mass mailings, targeted mailings, etc.” In fact, Byerly et al confirms this “teaching away” from Bucci through evidence that Byerly et al provides no mechanism or contingency *whatsoever* for mailing the advisory messages.

WITH REGARDS TO PERIODICITY OF THE RECEIPT OF THE MATERIALS BY THE END USER

Bucci: Materials are periodic, and are sent on a specified cycle “during a specified period of time” (column 1, line 64), generally occurring monthly, as seen in column 1, lines 7-9: “This invention relates to the mailing of bills, statements, advertising and other communications to millions of homes and businesses each month”. The examples illustrated in Bucci (column 3, table 1) of billing “subscribers” are as follows: Chemical Mortgage Co., J.C.P.&L., West Keansburgh Water, Hazlet Twp. Sewerage, Storer Cable, Citibank MasterCard, and American Express. All are “subscribers” that send bills on a *monthly* basis; therefore, Bucci sends out the materials on a regular, periodic, and cyclical basis.

Byerly et al: The advisory messages are distributed to end users on a non-regular, non-periodic, non-cyclical basis. In Byerly et al, a given advisory message is relayed to a "pharmacy patient" on an *incidental* basis. The incident that this is based on is the occurrence of a pharmacy transaction. In Byerly et al, a "pharmacy patient" that only gets a single prescription filled a year ends up receiving an advisory message only once during that year, which occurs when said single prescription is picked up by the "pharmacy patient".

RATIONALE – Bucci and Byerly et al teach away from each other with regard to timing of information delivery, in that in Bucci, the information is delivered on a regular/periodic/cyclical (monthly) basis, while in Byerly et al, the information is delivered on an incidental basis.

WITH REGARDS TO WHEN PAYMENT IS MADE IN RELATION TO THE CONSUMPTION OF PRODUCTS OR SERVICES

Bucci: The examples illustrated in Bucci (column 3, table 1) of billing "subscribers": Chemical Mortgage Co., J.C.P.&L., West Keansburgh Water, Hazlet Twp. Sewerage, Storer Cable, Citibank MasterCard, and American Express, are all entities that *bill* the end user, where the accounts are financially settled *after* the end user has consumed the products or services. Even with Chemical Mortgage, the end user is making use of a product (which in this instance is most likely a house), before it is fully paid for. This even applies to the Storer Cable bill (cable bills tend to not be prepaid).

Byerly et al: Byerly et al is in fact a "point of sale" system in a retail store environment of a pharmacy. This is confirmed in column 6, lines 49-50 of Byerly et al:

"The invention represents a significant advance in the field of point-of-sale systems in the pharmacy environment." As such, said system basically functions "during a pharmacy transaction" (column 2, line 21). The information comprises "billing information" (column 8, lines 5-6), but does it actually comprise a billing statement in the same manner that Bucci does? It indeed does not. In any given pharmacy

situation, it is "old and well known" for a "pharmacy patient" end user to financially settle the pharmacy transaction (in other words, pay for the prescription) *prior* to leaving the pharmacy with a given prescription and *prior* to consuming the product (although an exception could result where a pharmacy counter employee could allow a "pharmacy patient" end user to use a not-yet-paid-for inhaler during an acute asthma attack prior to the conclusion of the transaction). Any attempt to thwart payment at a given retail point-of-sale prior to product consumption is generally considered "shoplifting". In terms of Byerly et al, also it is logical that said "billing information" would also comprise a receipt.

RATIONALE – Bucci and Byerly et al "teach away" from each other with regard to billing practices, in that Bucci teaches where the end user is billed, and the accounts are financially settled *after* the consumption of goods and services take place, whereas Byerly et al teaches where the end user is billed, and the account is financially settled *prior* to the consumption of the goods by the "pharmacy patient" end user.

Conclusion

In view of the above arguments and evidence presented above and of record, Applicants request that the Examiner's obviousness rejection be reversed and the case remanded to the Examiner for allowance.

Respectfully submitted,

/Guy Kevin Townsend/

Guy Kevin Townsend
Reg. No. 34,033
Attorney-Agent for Applicant

Date: July 18, 2006

CLAIMS APPENDIX (37 CFR 41.37(c)(1)(viii))

CURRENT CLAIMS AS AMENDED PRIOR TO FINAL OFFICE ACTION:

(Original Claims 1-145 were canceled prior to the pending final office action).

146. (Rejected) A method of providing health reminders with transaction statements sent to or accessed by end users of financial cards and related financial card customer services, wherein the health reminder is not related to a product purchase listed on the transaction statement, said method comprising the steps of:

- a. providing said health reminder associated with transaction statements to said end users , wherein the health reminder is not related to a product purchase listed on the transaction statement and said financial cards and said related financial card services enables said end users to perform financial card functions relating to and comprising the purchase goods and services, and;
- b. wherein said method optionally further provides at least one of :
 - i. said health reminder acts as a health awareness tool for said end users;
 - ii. said health reminder comprises at least one health related reminder(s), tip(s), or suggestion(s) for said end users and/or individuals related to or otherwise associated with said end users with regards to any health-related topic(s), health-related preventive measure(s), medical check-up(s), medical examination(s), or medical procedure(s);
 - iii. said health awareness tool encourages said end users to take self-initiative or self-action to heed said health-related preventive measure(s), to schedule said medical check-up(s), said medical examination(s), or said medical procedure(s);
 - iv. said health awareness tool is not used to remind said end users of a preexisting or already scheduled doctor appointment, but rather to raise health awareness and to encourage said end users to self-schedule said medical check-up(s), said medical

examination(s), and/or said medical procedure(s) in absence of any direct prompting from the doctors or health care professionals of said end users;

said method optionally further comprising at least one of:

- (b) attracting potential end users to said financial cards and said related financial card customer services comprising said health reminder;
- (c) converting said potential end users into said end users by enabling said potential end users to apply for said financial cards and said related financial card customer services, where the application for said financial cards and said related financial card customer services reflects the preferences, desires, or consent of said end users to receive said health reminder, or, in the case of said health reminder being offered to existing end users of financial cards and related financial card customer services, where said existing end users express preferences, desires or consent to receive said health reminder, and comprising the step of providing said potential end users with the step of applying for said financial cards and said related financial card customer services, where said the step of applying for said financial cards and said related financial card customer services comprises the use of any communicative format;
- (d) approving said potential end users to become approved said end users of said financial cards and said related financial card customer services, where the receiving of said health reminder is contingent upon said potential end users becoming said approved said end users of said financial cards and said financial card customer services, and where said health reminder is offered as an incentive for said potential end users to become said end users for said financial cards and said related financial card customer services;
- (e) providing and relaying prompts to said end users relating to said health reminder, where said the step of providing and relaying prompts comprises the use of any communicative format, and where said step of providing and relaying prompts to said end users may occur at any time before, during, or after said potential end users have become said

approved end users of said financial cards and said related financial card customer services;

- (f) receiving end user data relating to said health reminder, where said step of receiving said end user data comprises the use of any communicative format, and where said step of receiving said end user data relating to said health reminder may occur at any time before, during, or after said potential end users have become said approved end users of said financial cards and said related financial card customer services;
 - (g) storing said end user data on a computer readable medium relating to said health reminder;
 - (h) allowing said end users to perform transactions relating to said financial cards and related financial card customer services, using said financial cards, resulting in transaction data;
 - (i) storing said transaction data on a computer readable medium;
 - (j) providing said health reminder to said end users based on said prompts and said end user data, where said step of providing said health reminder comprises the use of any communicative format; and,
 - (k) providing financial card transaction statements to said end users based on said transaction data, where said step of providing said financial card transaction statements comprises the use of any communicative format.
147. (Rejected) The method of claim 146, further comprising the step of enabling said method to function in terms of a financial card comprising a health reminder feature, or where said method functions in terms of a health reminder comprising a financial card feature, comprising the step of enabling an entity that provides said health reminder to also issue financial cards and provide related financial card customer services, where said financial cards and said related financial card customer services are specifically offered in conjunction with, specifically related or tied to, or otherwise specifically combined with said health reminder, and not where said entity issues said financial cards and provides said related financial card customer services where said health reminder is not specifically

offered in conjunction with, not specifically related or tied to, or not otherwise specifically combined with said financial cards and said related financial card customer services.

148. (Rejected) The method of claim 146, further comprising including the step of enabling said financial card to comprise any financial card used wholly or in part as a credit instrument.
149. (Rejected) The method of claim 146, further comprising including the step of enabling said financial card to comprise any financial card used wholly or in part as a debit or ATM instrument.
150. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to comprise information provided by the following entities, either singularly, or plurally in any combination or permutation: said entity; said end users; or a third party entity or third party entities, where said third party entity or said third party entities may or may not comprise entities in a health related field; further comprising including the step of enabling said entity, said end users, said third party entity or said third party entities to relay said information using any communicative format or technology.
151. (Rejected) The method of claim 146, further comprising including the step of enabling said prompts to comprise specific headings, questions, information, or guidelines that enable said end users to supply said end user data.
152. (Rejected) The method of claim 146, further comprising including the step of enabling said prompts to comprise specific headings, questions, information, or guidelines that have health related topicalities, where the totality of said prompts comprises the addressing of health related matters of said end users and where the intended purpose of said totality of said prompts is to raise said end users' awareness of health related issues pertinent to said end users.
153. (Rejected) The method of claim 146, further comprising including the step of enabling said reminders, tips, or suggestions to comprise both health related and non-health related topicalities, and comprising the step of enabling said prompts to comprise specific headings, questions,

information, or guidelines comprising both health related and non-health related topicalities.

154. (Rejected) The method of claim 146, further comprising including the step of providing said prompts to said end users either directly by said entity providing said health reminder, or indirectly via a third party or third parties, where said third party or said third parties may or may not comprise entities in a health related field, where said third party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity, and comprising the step of providing said prompts to said end users using any communicative format or technology.
155. (Rejected) The method of claim 146, further comprising including the step of adding, modifying, revising, or deleting said prompts by any party or parties deemed desirable, where said party or said parties comprise said entity, said end users, and/or associated third party entity or third party entities, where said third party entity or said third party entities may or may not comprise entities in a health related field, where said third party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity and/or said end users, and comprising the step of adding, modifying, revising, or deleting said prompts using any communicative format or technology.
156. (Rejected) The method of claim 146, further comprising including the step of enabling said end user data to comprise basic cardholder information.
157. (Rejected) The method of claim 146, further comprising including the step of enabling said end user data to comprise end user preferences information.
158. (Rejected) The method of claim 146, further comprising including the step of adding, modifying, revising, or deleting said end user data by any party or parties deemed desirable, where said party or said parties comprise said entity, said end users, and/or associated third party entity or third party entities, where said third party entity or said third party entities may or may not comprise entities in a health related field, where said third

party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity and/or said end users, and comprising the step of adding, modifying, revising, or deleting said end user data using any communicative format or technology.

159. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to comprise reminders, tips, or suggestions that are automatic, general, or non end user-specific in nature, and do not comprise basic end user information or end user preferences information.
160. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to comprise reminders, tips, or suggestions that comprise basic end user information to tailor said reminders, tips, or suggestions to said end users.
161. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to comprise reminders, tips, or suggestions that comprise end user preferences information that enables said end users to select, customize or tailor any or all aspects of said reminders, tips, or suggestions comprising parameters, content, text, etc, where the end results comprise the preferences or desires of said end users.
162. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to comprise reminders, tips, or suggestions that comprise any permutation or combination of: reminders, tips, or suggestions that are automatic, general, or non-end user specific in nature, and do not comprise basic end user information or end user preferences information; reminders, tips, or suggestions that comprise basic end user information to tailor said reminders, tips, or suggestions to said end users; or reminders, tips, or suggestions that comprise end user preferences information that enables said end users to select, customize or tailor any or all aspects of said reminders, tips, or suggestions comprising parameters, content, text, etc, where the end results comprise the preferences or desires of said end users.

163. (Rejected) The method of claim 146, further comprising including the step of acknowledging the receipt of said health reminder by said end users.
164. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to appear directly on said financial card transaction statements.
165. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to appear directly on said financial card transaction statements, where said financial card transaction statements comprise the step of separating the health reminder portion of said financial card transaction statements from said financial card transaction statements that enables said health reminder portion to be removed from and stored separately from the transaction portion of said financial card transaction statements.
166. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder to comprise a separate item in addition to said financial card transaction statements in the financial card transaction statement enclosures.
167. (Rejected) The method of claim 146, further comprising including the step of providing said health reminder to said end users independently of said financial card transaction statements or financial card transaction statement enclosures.
168. (Rejected) The method of claim 146, further comprising including the step of providing said health reminder directly by said entity to said end users, or including for providing said health reminder to said end users indirectly via a third party or third parties, where said third party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity.
169. (Rejected) The method of claim 146, further comprising including the step of selecting, by any party or parties deemed desirable, the communicative format of said health reminder and/or said financial card statements, where said party or said parties comprise said entity, said end users, and/or associated third party or third parties.

170. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder and said financial card transaction statements to comprise identical, similar or different communicative formats.
171. (Rejected) The method of claim 146, further comprising including the step of enabling said health reminder and/or said financial card transaction statements, either combined, not combined but sent together in the same enclosure, or sent separately, to be sent in a plurality of communications using identical, similar, or different communicative formats, further comprising including the step of enabling each of the said plurality of communications using identical, similar, or different communicative formats to comprise any combination or permutation of identical, similar, or different content.
172. (Rejected) The method of claim 146, further comprising including the step of enabling said method to comprise disclaimers.
173. (Rejected) The method of claim 146, further comprising including the step of enabling any or all method steps to be performed either directly by said entity; indirectly by a third party or third parties, where said third party or said third parties are associated with, retained by, referred by, or linked via Internet or intranet with said entity; or by any combination or permutation of said entity and said third party/said third parties.
174. (Rejected) The method of claim 146, further comprising including the step of enabling said method to be used in concert with special features or end user benefits intended for use with financial cards, or in concert with special features or end user benefits intended for use with a health reminder.
175. (Rejected) The method of claim 146, further comprising including the step of providing said health reminder, as provided by said entity providing said financial cards and said related financial card customer services, to the public at large in absence of said financial cards, said related financial card customer services, and said financial card transaction statements, where the said providing of said health reminder by said entity acts as a public service.

176. (Rejected) A system of providing health reminders as part of transaction statement provided to end users of financial cards and related financial card customer services, wherein the health reminder is not related to a product purchase listed on the transaction statement, , comprising:
- a. a computer based system for providing said said health reminder associated with transaction statements to said end users, wherein
 - i. the health reminder is not related to a product purchase listed on the transaction statement, and said financial cards and said related financial card services enable said end users to perform financial card functions relating to and comprising the purchase goods and services, and
 - b. wherein said system optionally further comprises at least one system component for providing at least one function or service selected from;
 - i. said health reminder acts as a health awareness tool for said end users of said financial cards and said related financial card customer services,
 - ii. said health reminder comprises at least one health related reminder(s), tip(s), or suggestion(s) for said end users and/or individuals related to or otherwise associated with said end users with regards to any health-related topic(s), health-related preventive measure(s), medical check-up(s), medical examination(s), or medical procedure(s), and
 - iii. said health awareness tool encourages said end users to take self-initiative or self-action to heed said health-related preventive measure(s), to schedule said medical check-up(s), said medical examination(s), or said medical procedure(s),
 - iv. said health awareness tool is not used to remind said end users of a preexisting or already scheduled doctor appointment, but rather to raise health awareness and to encourage said end users to self-schedule said medical check-up(s), said medical examination(s), and/or said medical procedure(s) in absence of

any direct prompting from the doctors or health care professionals of said end users;

said system optionally further comprises at least one system component for at least one of:

- c. attracting potential end users to said financial cards and said related financial card customer services comprising said health reminder;
- d. converting said potential end users into said end users by enabling said potential end users to apply for said financial cards and said related financial card customer services, where the application for said financial cards and said related financial card customer services reflects the preferences, desires, or consent of said end users to receive said health reminder, or, in the case of said health reminder being offered to existing end users of financial cards and related financial card customer services, where said existing end users express preferences, desires or consent to receive said health reminder, and comprising for providing said potential end users with for applying for said financial cards and said related financial card customer services, where said for applying for said financial cards and said related financial card customer services comprises the use of any communicative format;
- e. approving said potential end users to become approved said end users of said financial cards and said related financial card customer services, where the receiving of said health reminder is contingent upon said potential end users becoming said approved said end users of said financial cards and said financial card customer services, and where said health reminder is offered as an incentive for said potential end users to become said end users for said financial cards and said related financial card customer services;
- f. providing and relaying prompts to said end users relating to said health reminder, where said for providing and relaying prompts comprises the use of any communicative format, and where said for providing and relaying prompts to said end users may occur at any time before, during, or after said potential end users have become said approved

end users of said financial cards and said related financial card customer services;

- g. receiving end user data relating to said health reminder, where said for receiving said end user data comprises the use of any communicative format, and where said for receiving said end user data relating to said health reminder may occur at any time before, during, or after said potential end users have become said approved end users of said financial cards and said related financial card customer services;
 - h. storing said end user data on a computer readable medium relating to said health reminder;
 - i. allowing said end users to perform transactions relating to said financial cards and related financial card customer services, using said financial cards, resulting in transaction data;
 - j. storing said transaction data on a computer readable medium;
 - k. providing said health reminder to said end users based on said prompts and said end user data, where said for providing said health reminder comprises the use of any communicative format; and,
 - l. providing financial card transaction statements to said end users based on said transaction data, where said for providing said financial card transaction statements comprises the use of any communicative format.
177. (Rejected) The system of claim 176, further comprising a system component for enabling said system to function in terms of a financial card comprising a health reminder feature, or where said system functions in terms of a health reminder comprising a financial card feature, comprising enabling an entity that provides said health reminder to also issue financial cards and provide financial card customer services, where said financial cards and said related financial card customer services are specifically offered in conjunction with, specifically related or tied to, or otherwise specifically combined with said health reminder, and not where said entity issues said financial cards and provides said related financial card customer services where said health reminder is not specifically offered in conjunction with, not specifically related or tied to, or not otherwise

specifically combined with financial cards and said related financial card customer services.

178. (Rejected) The system of claim 176, further comprising a system component for enabling said financial card to comprise any financial card used wholly or in part as a credit instrument.
179. (Rejected) The system of claim 176, further comprising a system component for enabling said financial card to comprise any financial card used wholly or in part as a debit or ATM instrument.
180. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to comprise information provided by the following entities, either singularly, or plurally in any combination or permutation: said entity; said end users; or a third party entity or third party entities, where said third party entity or said third party entities may or may not comprise entities in a health related field; further comprising a system component for enabling said entity, said end users, said third party entity or said third party entities to relay said information using any communicative format or technology.
181. (Rejected) The system of claim 176, further comprising a system component for enabling said prompts to comprise specific headings, questions, information, or guidelines that enable said end users to supply said end user data.
182. (Rejected) The system of claim 176, further comprising a system component for enabling said prompts to comprise specific headings, questions, information, or guidelines that have health related topicalities, where the totality of said prompts comprises the addressing of health related matters of said end user and where the intended purpose of said totality of said prompts is to raise said end user's awareness of health related issues pertinent to said end user.
183. (Rejected) The system of claim 176, further comprising a system component for enabling said reminders, tips, or suggestions to comprise both health related and non-health related topicalities, and comprising for enabling said prompts to comprise specific headings, questions,

information, or guidelines comprising both health related and non-health related topicalities.

184. (Rejected) The system of claim 176, further comprising a system component for providing said prompts to said end users either directly by said entity providing said health reminder, or indirectly via a third party or third parties, where said third party or said third parties may or may not comprise entities in a health related field, where said third party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity, and comprising for providing said prompts to said end users using any communicative format or technology.
185. (Rejected) The system of claim 176, further comprising a system component for adding, modifying, revising, or deleting said prompts by any party or parties deemed desirable, where said party or said parties comprise said entity, said end users, and/or associated third party entity or third party entities, where said third party entity or said third party entities may or may not comprise entities in a health related field, where said third party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity and/or said end users, and comprising for adding, modifying, revising, or deleting said prompts using any communicative format or technology.
186. (Rejected) The system of claim 176, further comprising a system component for enabling said end user data to comprise basic cardholder information.
187. (Rejected) The system of claim 176, further comprising a system component for enabling said end user data to comprise end user preferences information.
188. (Rejected) The system of claim 176, further comprising a system component for adding, modifying, revising, or deleting said end user data by any party or parties deemed desirable, where said party or said parties comprise said entity, said end users, and/or associated third party entity or third party entities, where said third party entity or said third party entities may or may not comprise entities in a health related field, where said third party or said third parties may be associated with, retained by, referred by,

or linked via Internet or intranet with said entity and/or said end users, and comprising for adding, modifying, revising, or deleting said end user data using any communicative format or technology.

189. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to comprise reminders, tips, or suggestions that are automatic, general, or non end user-specific in nature, and do not comprise basic end user information or end user preferences information.
190. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to comprise reminders, tips, or suggestions that comprise basic end user information to tailor said reminders, tips, or suggestions to said end users.
191. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to comprise reminders, tips, or suggestions that comprise end user preferences information that enables said end users to select, customize or tailor any or all aspects of said reminders, tips, or suggestions comprising parameters, content, text, etc, where the end results comprise the preferences or desires of said end users.
192. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to comprise reminders, tips, or suggestions that comprise any permutation or combination of: reminders, tips, or suggestions that are automatic, general, or non-end user specific in nature, and do not comprise basic end user information or end user preferences information; reminders, tips, or suggestions that comprise basic end user information to tailor said reminders, tips, or suggestions to said end users; or reminders, tips, or suggestions that comprise end user preferences information that enables said end users to select, customize or tailor any or all aspects of said reminders, tips, or suggestions comprising parameters, content, text, etc, where the end results comprise the preferences or desires of said end users.
193. (Rejected) The system of claim 176, further comprising a system component for acknowledging the receipt of said health reminder by said end users.

194. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to appear directly on said financial card transaction statements.
195. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to appear directly on said financial card transaction statements, where said financial card transaction statements comprise for separating the health reminder portion of said financial card transaction statements from said financial card transaction statements that enables said health reminder portion to be removed from and stored separately from the transaction portion of said financial card transaction statements.
196. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder to comprise a separate item in addition to said financial card transaction statements in the financial card transaction statement enclosures.
197. (Rejected) The system of claim 176, further comprising a system component for providing said health reminder to said end users independently of said financial card transaction statements or financial card transaction statement enclosures.
198. (Rejected) The system of claim 176, further comprising a system component for providing said health reminder directly by said entity to said end users, or including to provide said health reminder to said end users indirectly via a third party or third parties, where said third party or said third parties may be associated with, retained by, referred by, or linked via Internet or intranet with said entity.
199. (Rejected) The system of claim 176, further comprising a system component for selecting, by any party or parties deemed desirable, the communicative format of said health reminder and/or said financial card statements, where said party or said parties comprise said entity, said end users, and/or associated third party or third parties.
200. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder and said financial card

transaction statements to comprise identical, similar or different communicative formats.

201. (Rejected) The system of claim 176, further comprising a system component for enabling said health reminder and/or said financial card transaction statements, either combined, not combined but sent together in the same enclosure, or sent separately, to be sent in a plurality of communications using identical, similar, or different communicative formats, further comprising a system component for enabling each of the said plurality of communications using identical, similar, or different communicative formats to comprise any combination or permutation of identical, similar, or different content.
202. (Rejected) The system of claim 176, further comprising a system component for enabling said system to comprise disclaimers.
203. (Rejected) The system of claim 176, further comprising a system component for enabling any or all system steps to be performed either directly by said entity; indirectly by a third party or third parties, where said third party or said third parties are associated with, retained by, referred by, or linked via Internet or intranet with said entity; or by any combination or permutation of said entity and said third party/said third parties.
204. (Rejected) The system of claim 176, further comprising a system component for enabling said system to be used in concert with special features or end user benefits intended for use with financial cards, or in concert with special features or end user benefits intended for use with a health reminder.
205. (Rejected) The system of claim 176, further comprising a system component for providing said health reminder, as provided by said entity providing said financial cards and said related financial card customer services, to the public at large in absence of said financial cards, said related financial card customer services, and said financial card transaction statements, where said providing of said health reminder by said entity acts as a public service.

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Art Unit: 3622

Appellant's Reply to New Grounds of Rejection in Examiner's Answer of 05-18-06

July 18, 2006

Evidence Appendix (37 CFR 41.37(c)(1)(x))

There is no evidence being submitted under 37 CFR 1.130, 1.131, or 1.132.

Evidence Appendix (37 CFR 41.37(c)(1)(x))

There are no related decisions identified according to 37 CFR 41.37(c)(1)(ii).